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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,053	02/27/2004	Wolfgang Holla	DEAV2003/0014 US NP	8335

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EXAMINER

LEE, SUSANNAH E

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/789,053	Applicant(s) HOLLA ET AL.	
	Examiner Susannah Lee	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☒ Claim(s) 2-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>062305</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claims 1-8 are pending in this application.

Priority

This application claims benefit of US Provisional Application No. 60/487,416 filed on 07/15/2003.

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d) of German Patent Application No. 10308350.2-42 filed on 02/27/2003. The certified ribbon copies of the above application filed on 02/27/2004 has been received.

Response to Election/Restrictions

Applicant's election *without traverse* of a group drawn to a process of preparing a chiral, nonracemic compound of formula (I), wherein R2 is (C1-8)alkyl; Ring A is phenyl; R3 is (C1-6)alkyl, R4 and R5 are hydrogen or (C1-6)alkyl; and n is 1 drawn to the process of making a compound of the formula in claim 1, in the reply filed on 05/13/2005 is acknowledged. Based upon the election, examiner will begin searching the process of making the above compound.

Scope of Elected Subject Matter

The scope of the invention of the elected subject matter is as follows: a process of preparing a chiral, nonracemic compound of the compound of claim 1, wherein R2 is (C1-8)alkyl; Ring A is phenyl; R3 is (C1-6)alkyl, R4 and R5 are hydrogen or (C1-6)alkyl; and n is 1 drawn to the process of making a compound of the formula in claim 1.

Based upon Applicant's election, Examiner will search various subclasses of classes 514 and 548. All compounds falling outside the class(es) and subclass(es) of the selected compound and any other subclass encompassed by the election above will be directed to nonelected subject

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matter and will be withdrawn from consideration under 35 U.S.C. 121 and 37 C.F.R. 1.142(b).

Applicant may reserve the right to file divisional applications on the remaining subject matter.

(The provisions of 35 U.S.C. 121 apply with regard to double patenting covering divisional applications.)

Scope of Withdrawn Subject Matter

Claim 1, where Ring A is 5-12 membered heteroaromatic ring which may contain from one to four heteroatoms from the group of N, O, and S, 8 to 14 membered aromatic ring, has been withdrawn from consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected subject matter. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112, 2nd paragraph

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, Claims 1, page 7, line 4, the phraseology "it being also possible...enantiomeric form" renders Claim 1 confusing and therefore the claim is indefinite. If applicant would like to claim the alternative steps, they may be written as separate claims.

Objections

Claim 4 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend on another multiple dependent claim, i.e. Claim 3. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits. This rejection can be obviated by replacing 3 with 2.

Claim 5 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must be written in the alternative and cannot depend on a multiple claim, i.e. Claims 3-4. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits. This rejection can be obviated by adding "any of" before the word claims and by replacing 4 with 2.

Claim 6 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend on itself. Claim 6 claims "the process as claimed in any of claims 1 to 6, wherein a compound of the formula (I)." This objection can be obviated by replacing 6 with 2. In addition, if it is no the number 6, but rather the number 5, it is still objected to because a multiple dependent claim cannot be dependent on another multiple

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dependent claim, i.e. Claims 3-5. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits. This objection can be obviated by replacing 5 with 2.

Claim 7 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend on another multiple dependent claim, i.e. Claims 3-6. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits. This rejection can be obviated by replacing 6 with 2.

Claim 8 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend on another multiple dependent claim, i.e. Claims 3-7. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits. This rejection can be obviated by replacing 7 with 2.

Claims 2-8 are objected to as being dependent upon a rejected base claim.

Interview Summary

A telephonic interview was held with attorney Barbara Kurys on 06/23/2005. The above issues were discussed and a written opinion was requested.

Telephone Inquiry

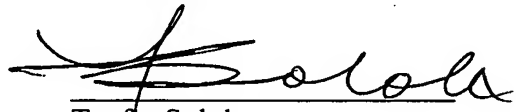
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Lee whose telephone number is (571) 272-6098. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Susannah Lee
Patent Examiner, AU 1626


Taofiq Solola
Primary Patent Examiner
AU 1626
Date: 06/24/05